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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,441	01/24/2002	Nicholas F. D'Antonio	DA9397US.CIP2 RE	2618
28672	7590	09/12/2006	EXAMINER	
D. PETER HOCHBERG CO. L.P.A. 1940 EAST 6TH STREET CLEVELAND, OH 44114			LEWIS, RALPH A	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/056,441	D'ANTONIO ET AL.	
	Examiner	Art Unit	
	Ralph A. Lewis	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Improper "Amendment to Reissue Application Declaration"

Declarations cannot be "amended." See MPEP 602.01. The person/persons making a declaration declare that all statement's made in the declaration are true or believed to be true and that any willful false statements are punishable by fine or imprisonment and may jeopardize the validity of any patent issuing from the application. Any changes made to the declaration require the same affirmation by the inventors.

Accordingly, the "amendment" to the declaration has not been entered. Supplemental declarations are provided for under 37 CFR 1.175.

Improper Amendments

The preliminary amendment filed with the application deleting the paragraph of column 1, lines 3-13 does not comply with 37 CFR 1.173(b)(1) and (d) which requires the paragraph to be written in its entirety and enclosed in brackets indication the deleted material.

The amendment of 16 June 2006 to the claims does not comply with 37 CFR 1.173(b)(2) and (d). The newly added claims need to be underlined in their entirety, See MPEP 1453 V for examples of proper claim amendments in reissue applications.

Defective Reissue Declaration

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Applicant's reissue declaration lists only one error, inadvertently claiming priority to applicant's earlier filed applications which "substantially shortened the term of their patent." 35 U.S.C. 251 prescribes the effect of reissue on the patent term by stating that "the Director shall . . . reissue the patent . . . for the unexpired term of the original patent." The office does not have the authority to extend the originally granted patent term through the issuance of a reissue. See MPEP 1405.

Rejections based on 35 U.S.C. 251

Claims 1-22 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect in the declaration is set forth in the discussion above in this Office action.

Comments

The material that applicant desires to add to the declaration would fail to make the declaration comply with 35 U.S.C. 251 even if properly submitted in a supplemental declaration because it fails to set forth an error upon which a reissue can be granted. If

applicant were to reference material added in one of the newly proposed dependent claims and indicate that the original patent was wholly or partly inoperative because patentees were claiming less than they had a right to, then the declaration would be proper under 35 U.S.C. 251.

In regard to the deletion of the priority applications/patents in the first column of the patent, it is noted that applicant is permitted to make such an amendment, however, it is noted that such action has no effect on the original patent term. 35 U.S.C. 251 is explicit and clear that a re-issue can only be granted for the unexpired term of the original patent. While that term may be shortened it cannot be extended. See MPEP 1405. The examiner, nor the Office, has the power or authority to extend the term of a patent in a reissued application.

Action Made Final

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


Art Unit: 3732

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (571) 272-4720.

R.Lewis
September 2, 2006



Ralph A. Lewis
Primary Examiner
AU 3732